UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,566	03/11/2004	Manish K. Deliwala	60655.8900	2565

66170   7590   06/16/2010
Snell & Wilmer L.L.P. (AMEX)
ONE ARIZONA CENTER
400 E. VAN BUREN STREET
PHOENIX, AZ 85004-2202

EXAMINER
OBEID, FAHD A

ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
06/16/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM
DMIER@SWLAW.COM
JESLICK@SWLAW.COM

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _02 June 2010_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-4,6-11 and 13-22_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-4, 6-11, and 13-22_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Status of the Application

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 06/02/2010 has been entered.

Preliminary Remarks

2.   This is in reply to communication filed on 06/02/2010.

3.   Claims 5 and 12 have been cancelled.

4.   Claims 1-4, 6-11, 13-17, and 20 have been amended.

5.   Claims 21-22 have been added.

6.   Claims 1-4, 6-11, and 13-22 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

8.   Claims 1-4, 6-11, and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1 and 21-22 recite the limitation "allocating, by the computer based system, billing to an

internal structure...ect." is vague and indefinite. It is confusing and unclear whether the

allocated billing data refers to the descriptive data or the value driver data. It is also unclear how

can billing be allocated if the computer based system did not receive any billing data. Thus the

limitation is not positively recited.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11.   **Claims 1-4, 6-11, and 13-20 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over MacFarlane (US 6,125,354) in view of Peterson (US 7,020,628).

12.   <u>Regarding Claim 1:</u> MacFarlane discloses a method comprising:

- receiving, by a computer based system for allocating billing, data corresponding to usage

  of a technology resource by a group within the entity, wherein the group is assigned a

  distinct group identifier *(fig.1 reference characters 108-122)*, and wherein a business

  model file of an entity comprises internal structure information including a list of a

  plurality of groups within the entity, and wherein the group is part of the plurality of

  groups (col 1 lns 27-42, col 2 lns 58-67, col 3 lns 20-26, col 3 lns 54-63);

- receiving, by the computer based system, value driver data *(re-price*

  parameters/miscellaneous charge) associated with the group (figs.1,4,&5; col 6 lns 57-

  64);

MacFarlane does not explicitly disclose that a usage is assigned a unique task identifier,

receiving descriptive data corresponding to the unique task identifier, and allocating billing

based on usage.

However, Peterson does teach a service bureau storing the starting and ending time

stamps in a memory, wherein the starting and ending time stamps are associated in a user log

with a list of authorized users, so that the user log contains a record of computer time usage for

each authorized user (col 4 lns 5-10).

Peterson teaches a user log "unique task identifier" for use by a billing computer to

generate bills (abstract). Maintaining a list of host computer networks and associated list of

authorized users for each network, creating a starting and ending time stamp for remote access

calls, transmitting the starting and ending time stamps in the user log to a billing computer in

addition to other billing information, and generating a billing summary of costs and usage at the

billing computer (col 5 lns 18-24)

Peterson teaches a bill may be generated that breaks up authorized users into various

departments to which they are assigned within an organization. For each authorized user in the

department a predetermined group of information may be displayed. The information may

include the cost of long distance telephone usage which is distributed among authorized users

based on the amount of time a user was communicating with the host computer network (col 4

lns 50-60). Furthermore, Peterson teaches a billing computer may generate monthly reports

dividing up the usage for each individual authorized user by total time used per a given period or

by tome of day or week so that host computer network or service bureau resources can be

Properly allocated for particularly heavy usage (col 5 lns 10-15). see also (col 4 lns 35-42).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to use Peterson's teachings in MacFarlane's "system and method for

generating an invoice charges to the elements of an organization" enabled, for the advantage of

monitoring the costs of remote users accessing the host computer or computer network of the

company, in addition to tracking the usage of computer time and various costs associated with

that time (Peterson; col 1 lns 27-30).

13.   Regarding Claim 2: MacFarlane discloses a method of claim 1, wherein the technology

resource includes at least one of, teleph0ony resource usage, manufacturing cycles, production

runs, and computer usage, wherein the computer usage includes computing time obtained from

an outsourced provider (col 6 lns 15-20 and col 8 lns 55-58).

14.   Regarding Claim 3: MacFarlane discloses a method of claim 1, wherein receiving said

business model file further includes receiving said business model file at a controller (figs 1-4,

col 1 lns 27-42, and col 3 lns 54-63).

15.   Regarding Claim 4: MacFarlane discloses a method of claim 1, further including

automatically recognizing at least one user (figs. 2-4 and col 8 lns 26-34).

16.   Regarding Claim 6: MacFarlane discloses a method of claim 4, wherein said allocating

further includes allocating loyalty points to the at least one user (figs. 2-4 and col 8 lns 26-34).

17.   Regarding Claim 7: MacFarlane discloses a method of claim 1, wherein said allocating

further includes reducing said billing by a monetary value of loyalty points (figs. 2-4 and col 8

lns 26-34).

18.   Regarding Claim 8: MacFarlane discloses a method of claim 1, wherein said allocating

further includes at least one of transferring, pooling and gifting loyalty points (figs. 2-4 and col 8

lns 26-28).

19.   Regarding Claim 9: MacFarlane discloses a method of claim 1, further including

providing a descriptive billing statement including at least a portion of said business model file

(fig.1, col 4 lns 45-48, and col 7 lns 10-14).

20.   Regarding Claim 11: MacFarlane discloses a method of claim 1, further including

adjusting said billing based upon at least one of a CPU-second used, a total CPU-seconds

expected to be used, a volume discount, a stepped-type of pricing, a peak/off-peak usage, a

geographic location, a service provided, a performance expectation, a location, a service level

scoring, a CPU cycle, a local power consumption cost, a physical site security, an increased site

security, an additional operational procedure needed to support increased sensitive data, a level

of fail over needed, a service level agreement, and an account data privacy requirement (figs 2-4,

abstract, and claim 1).

21.   Regarding Claim 17: MacFarlane discloses a method of claim 13, further including

performing data analysis of said computer usage using the at least one application performance

driver (fig.1, col 5 lns 1-12, and claim 4).

22.   Regarding Claim 18: MacFarlane discloses a method of claim 13, further including

suggesting a cost efficient usage practice (col 1 lns 42-46 and col 1 lns 61-65).

23.   Regarding Claim 19: MacFarlane discloses a method of claim 13, further including

requesting a bid based upon said monitoring step (col 3 lns 31-40).

24.   Regarding Claim 20: MacFarlane discloses a method of claim 1, wherein said business

model file further includes at least one of an application profile, a value driver, a user level, a

geographic area, a project, a zone, a third party provider, loyalty information and a rule (col 3 lns

31-40 and col 4 lns 1-8).

25.   Regarding Claims 10 and 13-16:   MacFarlane does not explicitly disclose a computer usage includes computing time obtained from an outsourced provider, monitoring computer usage, and notifying at least one user of said computer usage.

However, Peterson does discloses a method of claim 1 wherein said technology resources includes at least one of computer usage, wherein said computer usage includes computing time obtained from an outsourced provider, telephony resource usage, manufacturing cycles and production runs (col 1 lns 17-18 and col 4 lns 7-10); Monitoring said computer usage (col 1 lns 46-50); notifying the at least one user of said computer usage (col 5 lns 10-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the computer of the company (Peterson; col 1 lns 27-29).

Response to Arguments

26.   Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant argues that: a) receiving, by the computer based system, value driver data *(re-price parameters/miscellaneous charge)* associated with the group (figs.1,4,&5; col 6 lns 57-64);

In response to a) examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. MacFarlane teaches applying re-price parameters for a division within an organization (fig.1). Applying miscellaneous charges for a

user (fig.5). The re-priced parameters are selected by the customer in connection with the

rebilling procedure. If the check box is filled or activated, then the billed charges are re-billed to

the desired elements of the organization (col 4 lns 55-62) (also col 8 lns 25-34.

Therefore, MacFarlane in view of Peterson still meets the scope of the limitation as currently

claimed.

Conclusion

27.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324.

The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627

June 11, 2010